

REMARKS

The Examining Attorney has rejected Claims 1-4,8, 11 and 14 under 35 U.S.C. 102(b) as being anticipated by Abbott (US 5,465,941). With regards to Claim 1, the Examining Attorney stated:

“As to claim 1, Abbott discloses a retaining-locking system for chain link fence slats, comprising:

a plurality of fence slat elements **60**, the slat elements being sized and shaped to be interwoven between consecutive links **12** of a chain link fence;

each of the slat elements having a first end, a second end, a front surface **78**, a back surface **80**, a first side edge **82**, a second side edge **82** and a notch **80** orthogonally oriented to a long axis of the slat, being disposed between the first end and the second end and extending inwardly from the first side edge toward the second side edge for a first predetermined distance;

a retaining-locking strip **64**, the strip being formed of resilient material, having a first end, a second end, an inner surface **A** (Figure 7 reprinted with annotations below), an outer surface **B**, an upper edge **76**, a lower edge **72** and a securing protrusion **75**;

the securing protrusion having a base, a back surface, an upper surface **76**, a lower surface **75** and being sized and shaped to fit slidably within the notch and being disposed upon the outer surface of the strip; and

whereby, when the slat elements are interwoven into between consecutive links of a chain link fence with each of the notches aligned with one another, the retaining locking strip inserted between the slat elements and the links, oriented orthogonally to the slats

with the securing protrusion disposed within the slats, the strip will urge the slats toward the links, thereby retaining the slats within the chain link fence (Figures 6-9).”

Applicant has amended Claim 1 and the Specification, to conform to the Figures. As can be clearly seen in **Figure 1**, the notch **60** extends from front surface **40** toward back surface **45**, rather than from first side edge **50** toward second side edge **55**. This construction is also seen in **Figures 2, 2A and 3**. No new material has been added. Thus the construction of the slat elements of the present invention is substantially different from that shown in *Abbot*. In *Abbott* the notches do extend from the lateral edges **82** in **Figures 7-9** toward the opposite edge. While *Abbot* requires two notches and a slat formed of resilient material,

“Inserting the bottom end of the slat 60 further into the rail channel 84 allow the slat ears 62 to elastically reform so that the front and back walls 78 and 80, respectively, regain their original spaced apart distance. When the slat 60 is completely seated in rail 64, retaining section 76 is positioned over a narrow section 67 of back wall 80 (see FIG. 8) between notches 66. This narrow section of the back wall is less resistant to bending and allows the retaining section 76 to deform the back wall toward front wall 78 without significantly altering the original distance between the front and back walls of the slat ears 62. Thus, the slat ears seat underneath retaining section 76 locking the slat 60 to rail 64.”

(Column 6, lines 52-63) (Emphasis added)

the slats of the present invention do not require such resilience. In *Abbot* the tips of the slats are deformed as they enter rail channel **84** of rail **64**. Further, as shown in **Figures 7 and 8** of *Abbot*, the notches of slat **60** must be located adjacent the top and/or bottom of the slat as the rail

channel is shaped to snap over the ends of the slats with the deformation of the slat ears **62**. In contrast, the single notch **60** of the present invention can be located at any point between the first end **30** and the second end **35**. Thus the means by which the slats are secured to the fence links in *Abbot* is significantly different than that found in the present invention.

The Examining Attorney describes the retaining-locking strip as:

“a retaining-locking strip **64**, the strip being formed of resilient material, having a first end, a second end, an inner surface **A** (Figure 7 reprinted with annotations below), an outer surface **B**, an upper edge **76**, a lower edge **72** and a securing protrusion **75**,”

Abbot refers to reference **76** as seen in **Figure 7**, as “the retaining section” rather than an upper edge and reference **72** as “a horizontally aligned base” rather than a lower edge. Reference **75** is described as “a section” coupling retaining section **76** to the top end of the fastening wall **74**. Rail **64** in *Abbot* serves to provide a rail channel **84** which supports the lower end of slat **60**. Thus rail **64** is used to secure slats **60** in a manner substantially different from that seen in the present invention.

The Examining Attorney describes the securing protrusion as follows:

“the securing protrusion having a base, a back surface, an upper surface **76**, a lower surface **75** and being sized and shaped to fit slidably within the notch and being disposed upon the outer surface of the strip;”

Abbot refers to reference **76** as “the retaining section”, rather than an upper surface. The Examining Attorney had previously referred to it as “an upper edge.” Likewise, *Abbot* refers to reference **75** as “a section” coupling retaining section **76** to the top end of the fastening wall **74**.

The Examining Attorney had previously referred to it as “a securing protrusion.” Applicant submits that reference 75 cannot refer to both a “securing protrusion” and a “lower surface” of that same “securing protrusion”.

“Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*”

Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed. Cir. 1984)

As seen above, every element of Claim 1 is not shown in *Abbot* and further, the elements shown are not arranged as in the claim. Rather, the Examining Attorney has relabeled the elements of *Abbot* in an attempt to show that these elements fall within the language of Claim 1.

“Invalidity for anticipation requires that all of the elements and limitations of the claim are found within a single prior art reference. . . . There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention.” *Scripps Clinic & Research Found. v. Genentech Inc.*, 18 USPQ 2d 1001, 1010 (Fed. Cir. 1991)

While the invention shown in *Abbot* is a device for retaining privacy slats in a chain link fence, it functions in a decidedly different manner (notches extending inwardly from the side edges of the slats, deformable “ears” on the slat ends), must be fabricated of different materials (resilient slat material) to function properly, and includes functional limitations (retainers may be fitted only at the tops or bottoms of the slats) not found in the present invention.

Further, the present invention includes at least one element not found in *Abbot*. The present invention includes a notch extending from the front surface of the slat (surface facing outwardly from the fence links) toward the back surface (surface facing the fence links). In

contrast, *Abbot* describes a pair of notches extending from the lateral edges of the slats toward their opposite edges (See **Figures 6 and 8**). As such, *Abbot* cannot be said to anticipate Claim 1 under 35 USC §102(b).

With regards to Claim 2, the Examining Attorney states:

“As to claim 2, Abbott discloses a retaining-locking system wherein the notch 80 in each of the slat elements 60 is rectangular in cross-section (Figure 9).”

Figure 9 actually discloses “a top sectional view of the locking system shown in **Fig. 6**” (Column 4, lines 5-6). **Figure 6** discloses “... a tubular slat locking system according to another embodiment of the invention” (Column 3, lines 66-67). Reference **80** refers to the back wall of slat **60** (Column 6, lines 31-31). The apparently rectangular “notch” is, in fact, a cross-sectional view of a tubular slat. The notches disclosed in *Abbot*, as shown most clearly in **Figures 6 and 8**, are actually curved, with a flat bottom surface. In contrast, **Figures 1, 2, 2A and 3** of the present application clearly show notch **60** having a rectangular cross section. Thus *Abbot* cannot be said to anticipate Claim 2.

With regards to Claim 3, the Examining Attorney states:

“As to claim 3, Abbott discloses a retaining-locking system wherein the inner surface A of the retaining-locking strip 64 is concave and the outer surface B of the retaining-locking strip is convex (Figure 7).”

As Claim 3 includes all of the limitations of Claim 1, and Claim 1 has been shown to include elements not found in *Abbot* and thus not anticipated by this reference, Claim 3 is likewise not anticipated.

With regards to Claim 4, the Examining Attorney states:

“As to claim 4, Abbott discloses a retaining-locking system wherein the inner surface A of the retaining-locking strip 64 is substantially parallel to the outer surface B of the retaining-locking strip when the strip is compressed between the securing protrusion 75 and the inner surface (Figure 7).”

Abbot identifies reference 75 as “a section” coupling retaining section 76 to the top end of the fastening wall 74. If rail 64 is compressed between section 75 and the “outer surface” B, this action will not urge the “inner surface” A to be parallel to the “outer surface” B. Further, as Claim 4 includes all of the limitations of Claim 1, and Claim 1 has been shown to include elements not found in *Abbot* and thus not anticipated by this reference, Claim 4 is likewise not anticipated.

With regards to Claim 8, the Examining Attorney states:

“As to claim 8, Abbott discloses a retaining-locking system wherein either of the first end and the second end of the slat element 60 is pointed, thereby permitting the retaining-locking strip 64 to be interwoven first between consecutive links 12 of the chain link fence and successive slat elements to then be interwoven orthogonally between consecutive links of the chain link fence, the pointed end permitting the slat element to compress the retaining-locking strip until the securing protrusion 75 is aligned with the notch 80 (Figures 6 and 8).

Slats 60 of *Abbot*, as shown in Figures 6 and 8, are not, in fact pointed. Rather, as shown clearly in Figure 7, the slats 60 are of full width on their bottom surfaces. While these slat bottoms are slightly curved, they are not pointed as are those of the present invention. See Figures 2, 2A and 3 of the present application, plainly showing the pointed lower ends of the

slats 20. Further, as Claim 8 includes all of the limitations of Claim 1, and Claim 1 has been shown to include elements not found in *Abbot* and thus not anticipated by this reference, Claim 8 is likewise not anticipated.

With regards to Claim 11, the Examining Attorney states:

“As to claim 11, Abbot discloses a retaining-locking system wherein the slat elements 60 are of tubular construction (Figure 9).”

As Claim 11 includes all of the limitations of Claim 1, and Claim 1 has been shown to include elements not found in *Abbot* and thus not anticipated by this reference, Claim 11 is likewise not anticipated.

With regards to Claim 14, the Examining Attorney states:

“As to claim 14, Abbott discloses a retaining-locking system wherein the inner surface A of the retaining-locking strip 64 is concave and the outer surface B of the retaining-locking strip is convex, the retaining-locking strip having a securing protrusion 75 disposed at a point spaced from at least one of the upper edge 76 and the lower edge 72 of the strip (Figure 7).”

Abbot identifies reference 75 as “a section” coupling retaining section 76 to the top end of the fastening wall 74, rather than a securing protrusion. *Abbot* also identifies reference 72 as a “horizontally aligned base” rather than a lower edge of the strip and 76 as a “retaining section” rather than an upper edge, in descriptions relating to **Figure 7, 8 and 9**. As such, the elements of Claim 14 are not shown in *Abbot*. Further, As Claim 14 includes all of the limitations of Claim 1, and Claim 1 has been shown to include elements not found in *Abbot* and thus not anticipated by this reference, Claim 14 is likewise not anticipated.

With regards to Claim 12, the Examining Attorney states:

“Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Abbott in view of *Finkelstein* (US 5,465,941).

As to claim 12, Abbott fails to disclose a retaining-locking system wherein the slat elements include an internal reinforcing rib.

Finkelstein teaches a retaining-locking system wherein slat elements 20 include an internal reinforcing rib 31; the rib providing for a more rigid slat element and preventing crimping of the slat element during installation (column 3 lines 24-29, Figure 2).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify a retaining-locking system as disclosed by *Abbott* to have slat elements including an internal reinforcing rib as taught by *Finkeistein* in order to provide for a more rigid slat element and prevent crimping of the slat element during installation.”

As Claim 12 includes all of the limitations of Claim 1, and Claim 1 has been shown to include elements not found in *Abbot*, the combination of *Abbot* and *Finkelstein* will not yield the present invention. As such, it would not be obvious to one ordinarily skilled in the art to make the combination of these two references. Further, neither reference contains any teaching or suggestion to make the combination proposed by the Examining Attorney.

Obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. The prior art of record fails to

provide any such suggestion or incentive. *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 221 USPQ 929, 932, 933 (Fed. Cir. 1984)

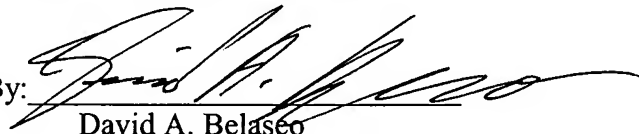
Applicant submits, therefore, that with the above-suggested changes to the Specification and the Claims and based on the above arguments, the application is now in condition for allowance.

Respectfully submitted,

BELASCO JACOBS & TOWNSLEY, LLP

Dated: April 15, 2005

By:

A handwritten signature in black ink, appearing to read "David A. Belasco", written over a horizontal line.

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